

**Rejection of Claims 1-7 under 35 U.S.C. § 102(e) - Ward**

The Examiner has rejected claims 1-7 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 5,974,320 (hereinafter Ward). Applicant respectfully traverses this rejection.

As a preliminary matter, Ward fails to mention the downloading of re-programming data. Indeed, Ward apparently relates to handovers between cells within a neighborhood zone that clearly would not require a downloading of re-programming data by the mobile station. While column 6, lines 1-15 of Ward apparently mentions a handover between a neighborhood zone and a public land mobile network (PLMN), no mention is made of downloading re-programming data.

In contrast, method claim 1 relates to downloading re-programming data from a network for installation. Notwithstanding, Ward fails to anticipate the claimed first dedicated channel.

The Examiner alleges that the measurement channel of Ward corresponds to the claimed first dedicated channel and that the data that identifies frequencies (neighborhood list) to be monitored by the mobile station of Ward corresponds to the claimed frequency and radio access parameters of a second channel for which reprogramming data may be downloaded.

Assuming *arguendo*, that the measurement channel of Ward corresponds to the claimed first dedicated channel, the data that identifies frequencies (neighborhood list) of Ward fails to correspond to the claimed radio access parameters of a second channel from which reprogramming data may be downloaded, as recited in claim 1.

Ward discloses that the neighborhood list provides measurement channel frequencies. (Column 1, lines 45-55 of Ward). The mobile station scans particular frequencies and measures (e.g. signal strength) on said measurement channels. (Summary of Invention; column 4, lines 42-46; Column, 5, lines 13-14 of Ward). Indisputably, the neighborhood list of Ward fails to include radio access parameters and such information is not necessary. In addition, as stated above, Ward is silent as to downloading reprogramming data.

For at least these reasons, Ward fails to anticipate method claim 1. Since claims 2-7 incorporate the limitations of claim 1, then Ward fails to anticipate claims 2-7 for reasons similar to those presented above with respect to claim 1.

Accordingly, Applicant respectfully requests that the rejection of claims 1-7 under 35 U.S.C. § 102(e) be withdrawn.

#### **Rejection of Claims 8-13 under 35 U.S.C. § 103(a) - Ward and Coursey**

The Examiner has rejected claims 8-13 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ward in view of U.S. Patent No. 5,950,130 (hereinafter Coursey). Applicant respectfully traverses this rejection.

The measurement channel and neighborhood list of Ward fails to teach or suggest the claimed broadcasting of claim 8. As stated above, Ward fails to teach or suggest the radio access parameters of a second channel. Indeed, there is no suggestion in Ward to include this type of information since Ward relates to handover within a home network. Moreover, Ward fails to

disclose or suggest this type of information when a handover occurs between the neighborhood zone and a PLMN.

Additionally, Coursey apparently makes use of a control or traffic channel to permit reprogramming of a mobile station and there is no suggestion that the claimed first channel is necessary to perform such an operation.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03 (8<sup>th</sup> Edition); In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). In view of the prior art as a whole, Ward and Coursey, individually or in combination, fail to teach or suggest all the limitations of claim 8.

Additionally, the Examiner alleges that it would have been obvious to a skilled artisan, at the time the invention was made, to have modified Ward to include over-the-air reprogramming as allegedly taught by Coursey. Applicant respectfully disagrees.

One skilled in the art would have recognized that Ward apparently relates to handovers, while Coursey apparently relates to roaming. As disclosed in Coursey, “roaming” occurs when a call is handled outside the user’s home network area (column 3, lines 21-29) and “hand-off” relates to passing from one cell to another cell. (Column 2, lines 60-63). Therefore, one skilled in the art would have readily distinguished that each reference addresses a distinct problem and takes a distinct approach.

In view of the above, a skilled artisan would not have modified Ward in the manner suggested by the Examiner. The modification suggested by the Examiner would be unduly

burdensome and one skilled in the art would have been deterred in doing so. For example, the control system 61 of Coursey and other operational information and programs related to intelligent roaming and logic features would have to be implemented. However, the mobile phone and network infrastructure of Ward does not include the features necessary for over the air reprogramming, as allegedly taught by Coursey, and one skilled in the art would not have been motivated to pursue such a modification, as suggested by the Examiner.

Additionally, if a skilled artisan had been motivated to modify Ward to include reprogramming of the mobile station, one skilled in the art would not have used the measurement channel of Ward, that allegedly corresponds to the first channel, to broadcast the claimed radio access parameters, of the control channel of Coursey, that allegedly corresponds to the second channel of claim 8. Rather, one skilled in the art would have discarded the use of the measurement channel of Ward to perform over the air reprogramming and would have used only the control or traffic channel, as allegedly taught by Coursey. (Column 23, 4-17 of Coursey). Therefore, assuming a skilled artisan had modified Ward, it would not have been the modification suggested by the Examiner. Moreover, the combination or modification would not have resulted in a method that would render obvious method claim 8.

For at least these reasons, Ward and Coursey, individually or in combination, fail to render obvious the method of downloading re-programming data of claim 8. Applicant respectfully requests that the rejection of claim 8 and dependent claims 9, 10, 12 and 13 under 35 U.S.C. § 103(a) be withdrawn.

Response Under 37 C.F.R. § 1.111  
U.S. Application No. 09/245,354

Attorney Docket No. Q53197  
Confirmation No. 4832

For the reasons presented above, Ward and Coursey fails to render obvious claim 11.

Therefore, Applicant respectfully requests that the rejection of claim 11 be withdrawn.

### Conclusion

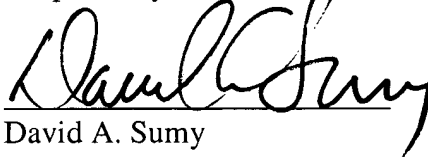
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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Respectfully submitted,



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